

In re Application of MARTINSEN et al.
Serial No. 09/677,445

RECEIVED
CENTRAL FAX CENTER
JUL 05 2006

REMARKS

The Office action has been carefully considered. The Office action rejected claims 1-6 and 9-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,266,681 to Guthrie ("Guthrie") in view of U.S. Patent No. 6,668,369 to Kerbs et al. ("Kerbs"). Applicants respectfully disagree.

By present amendment, claims 1, 6, 10, 11, 12 18, 24, 25, and 29 have been amended. Applicants submit that the claims as filed were patentable over the prior art of record, and that the amendments previously made were for purposes of clarifying the claims and/or for expediting allowance of the claims and not for reasons related to patentability. Reconsideration is respectfully requested.

Applicants thank the Examiner for the interview held (by telephone) on May 17, 2006. During the interview, the Examiner and applicants' attorney discussed the claims with respect to the prior art. The essence of applicants' position is incorporated in the remarks below.

Prior to discussing reasons why applicants believe that the claims in this application are clearly allowable in view of the teachings of the cited and applied references, a brief description of the present invention is presented.

The present invention is generally directed, in part, to a method for handling "element behaviors" in web pages. In the past, behaviors were attached in a loosely associated way to a respective element; such behaviors are thus referred to as "attached behaviors." For example, when a web page was accessed by a browser and subsequently processed, an attached behavior was not interpreted until needed, e.g., in order to save time and computing power. Although the

In re Application of MARTINSEN et al.
Serial No. 09/677,445

component remained attached to an associated element, it was not executed until some later interpretation time, and thus an "attached" behavior is considered as asynchronously binding to the element.

According to an embodiment of the present invention, however, an "element" behavior is synchronously bound to a respective element, e.g., once an element behavior has been downloaded and parsed, it exists as a first-class element in the document hierarchy and remains permanently bound to an element. To this end, instantiation occurs at the time of parsing to create an instance of the element behavior. Because the element behavior component is synchronously bound to the element, various advantages exist relative to attached behaviors, as detailed in the specification.

Note that the above description is for example and informational purposes only, and should not be used to interpret the claims, which are discussed below.

Turning to the rejections, the Office action rejected claim 1 as being unpatentable over Guthrie in view of Kerbs. More specifically, the Office action contends that Guthrie teaches a method comprising interpreting a page, the page comprising an import instruction that references a behavior component and an element synchronously bound to the behavior component. Column 5, lines 14-18 and 33-34 of Guthrie are referenced. Further, the Office action contends that Guthrie teaches determining a behavior of the element on the page by instantiating the behavior component in accordance with the import instruction prior to interpreting the element. Column 5, lines 26-29 of Guthrie are referenced.

In re Application of MARTINSEN et al.
Serial No. 09/677,445

The Office action contends that combining the teachings of Guthrie with the teachings of Kerbs would have been obvious to a person skilled in the art at the time the invention was made because it would have allowed Web developers to implement modularity in their site designs in order to simplify updates and alterations. Applicants respectfully disagree.

To establish *prima facie* obviousness of a claimed invention, all of the claim recitations must be taught or suggested by the prior art; (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)), and "all words in a claim must be considered in judging the patentability of that claim against the prior art;" (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geister*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). Moreover, if a modification would render a reference unsatisfactory for its intended purpose, the suggested modification / combination is impermissible. See MPEP § 2143.01.

Applicants submit that the Office action has failed to establish a *prima facie* case for obviousness. Specifically, Guthrie simply does not teach that which the Office action contends. Guthrie teaches, generally, a method and system for injecting code into a web document prior to interpretation; to do so Guthrie requires an injection system installed as an intermediary between the user's current browser and any server. Guthrie, column 7, line 52-colum 8, line 9. More specifically, the cited and applied section of Guthrie discloses an injector system operable to inject

In re Application of MARTINSEN et al.
Serial No. 09/677,445

code into an HTML document. Significantly, the code injected by Guthrie is not bound to any element.

Guthrie continues; when an HTML document is requested by a browser, the injector system "intercepts" the returning HTML document, injects some HTML code into the HTML document in the form of an injectable component, and then passes the modified HTML document to the browser for interpretation in a normal manner. See, generally column 5, lines 13-34. Consequently, the browser is unaware (*i.e.*, the injection is transparent) of any change to the HTML document and interprets the modified HTML document according to known conventional methods regardless of what HTML code may have been injected.

As can be seen with respect to the example detailed above, Guthrie does not teach or even suggest the concept of a behavior, let alone a behavior synchronously bound to an element as claimed by applicants. Indeed, the browser of Guthrie parses and interprets already injected code as it would normally do (see Fig. 11 of Guthrie, however note that "Parse" is spelled as "Pause" and "Interpret" as "Interperate" in this Guthrie's drawing), and thus cannot operate at the time of (when) parsing, as claimed. Applicant's note that Guthrie is silent as to anything even remotely resembling a "behavior" as claimed.

Guthrie does not teach or even suggest the manner of how to process an HTML document once passed to the browser, and teaches away from behaviors, by teaching the need for injecting code, and that that the injection is transparent to the browser. In other words, Guthrie teaches that an intermediary code injector is required, and that the parser and interpreter of Guthrie's browser does not even

In re Application of MARTINSEN et al.
Serial No. 09/677,445

realize that the code was injected; Guthrie thus cannot be construed to teach a behavior synchronously bound at the time of browser parsing. Guthrie specifically teaches that the post-authoring modified HTML document is interpreted like any other HTML document.

Additionally, the combination of the teachings of Guthrie with the teachings of Kerbs is counterintuitive, since the system of Guthrie is specifically directed to injecting code before processing by the browser. It simply does not make sense to inject DHTML code into an HTML document in Guthrie because one intended purpose of using DHTML code is to avoid the need for injecting additional code into a web page. That is, DHTML code avoids the need for injected code, along with the required intermediary injector, and so forth; one skilled in the art would not look to an injector (Guthrie) and Kerbs (general DHTML awareness) for a solution to the problems solved by the present invention, and indeed, even if one did, would not reach the present invention as claimed, including synchronously bound behaviors. Such a combination is simply illogical, and to suggest that the teachings of Kerbs (general DHTML awareness), and Guthrie (which teaches away from behaviors processed by a browser) can somehow be combined to render obvious the recitations of claim 1 is impermissibly broad and conclusory. Such broad, conclusory statements do not come close to adequately addressing the issue of motivation to combine, are not evidence of obviousness, and therefore are improper as a matter of law. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Further, if anything, the references teach away from such a combination, as discussed above. Indeed, the only way the references may

In re Application of MARTINSEN et al.
Serial No. 09/677,445

be combined is via impermissible hindsight knowledge gleaned from applicants' teachings.

For at least the foregoing reasons, applicants submit that claim 1 is allowable over the prior art of record.

Applicants respectfully submit that dependent claims 2-6 and 9-17, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 1 and consequently includes the recitations of independent claim 1. As discussed above, Guthrie and Kerbs, whether considered separately or in any permissible combination with each other or any other prior art of record, fails to teach or suggest the recitations of claim 1 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 1 noted above, each of these dependent claims includes additional patentable elements.

For example, claim 9 recites that the behavior component comprises content, and wherein instantiating the behavior component comprises inserting the content into the page. Guthrie cannot possibly be construed to teach a behavior component that, when instantiated, acts in this way. In effect, for claim 9 to read on the prior art, Guthrie would have to disclose that its injectable component is, in turn, a component itself for injecting additional code (or content). Thus, it is counterintuitive and illogical to the system of Guthrie to inject code that is operable to inject yet more code. Applicants submit that for at least this additional reason, claim 9 is allowable over the prior art of record.

In re Application of MARTINSEN et al.
Serial No. 09/677,445

Turning to the next independent claim, applicants again submit that the Office action has failed to establish a *prima facie* case for obviousness. As discussed previously, Guthrie does not teach that which the Office action contends. Guthrie teaches, generally, a method and system for injecting code into a web document prior to interpretation. More specifically, the cited and applied section of Guthrie discloses an injector system operable to inject code into an HTML document

As can be seen with respect to the example detailed above, Guthrie does not teach that a behavior (which is an encapsulated component) may be synchronously bound to an element as claimed by applicants. Moreover, the system and method in Guthrie is neither concerned with nor even aware of the nature of the injectable component and certainly cannot be construed to teach a behavior instantiated and synchronously bound to an element at the time of parsing.

Furthermore, the Office action has once again not addressed the claim language directed to creating a document fragment, and maintaining the document fragment separate from the document structure. Indeed, the injected content of Guthrie is maintained directly with the loaded web page prior to browser processing.

Additionally, as discussed above, the combination of Guthrie with the teachings of Kerbs is counter-intuitive since the system of Guthrie is specifically directed to injecting code to be parsed by the browser, whereas DHTML code avoids the necessity of injecting additional code into a web page. To suggest that

In re Application of MARTINSEN et al.
Serial No. 09/677,445

the teachings of Kerbs (general DHTML awareness) would render obvious the recitations of claim 18 is impermissibly broad and conclusory, and is based solely on hindsight knowledge impermissibly gleaned from applicants' teachings. For at least the foregoing reasons, applicants submit that claim 18 is allowable over the prior art of record.

Applicants respectfully submit that dependent claims 19-23, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 18 and consequently includes the recitations of independent claim 18. As discussed above, Guthrie and Kerbs, whether considered individually or in any permissible combination with each other or any other prior art of record, fail to teach or suggest the recitations of claim 18 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 18 noted above, each of these dependent claims includes additional patentable elements.

Turning to the next independent claim, the Office action rejected claim 25 as being unpatentable over Guthrie in view of Kerbs. Once again, column 5, lines 14-18, 26-29 and 33-34 of Guthrie have been referenced in addition to general DHTML awareness from Kerbs. Applicants respectfully disagree.

Again, Guthrie teaches, generally, a method and system for injecting code into a web document prior to interpretation but does not teach attaching or binding a behavior to an element, let alone synchronous binding. Guthrie simply does not disclose or even suggest a behavior bound to an element as claimed by applicants. Moreover, the injection of Guthrie teaches away from such a concept. Kerbs,

In re Application of MARTINSEN et al.
Serial No. 09/677,445

whether considered alone or in any permissible combination with Guthrie, does not cure this major deficiency of Guthrie.

Applicants submit that claim 25 is allowable over the prior art of record for at least these reasons.

Turning to the remaining claims, new independent claims 30 and 31 also recite elements at least similar to those that are clearly patentable over the prior art of record as recited in claims 1, 18, and 25 as discussed above. As has been clearly shown above, Guthrie and Kerbs are merely examples of the prior art that exhibits the problems enumerated in the background section of the present specification. Applicants submit that claims 30 and 31, as well as dependent claims 26-28 (which depend from claim 25) are allowable over the prior art of record for at least similar reasons.

For at least the foregoing reasons, applicants submit that all the claims are patentable over the prior art of record. Reconsideration and withdrawal of the rejections in the Office action is respectfully requested and timely allowance of this application is earnestly solicited.

In re Application of MARTINSEN et al.
Serial No. 09/677,445

RECEIVED
CENTRAL FAX CENTER

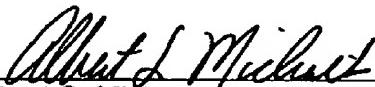
JUL 05 2006

CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 1-6, 9-23, 25-28, 30 and 31 are patentable over the prior art of record, and that the application is in good and proper form for allowance. A favorable action on the part of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 836-3030.

Respectfully submitted,


Albert S. Michalik, Reg. No. 37,395
Attorney for Applicants
Law Offices of Albert S. Michalik, PLLC
704 - 228th Avenue NE, Suite 193
Sammamish, WA 98074
(425) 836-3030
(425) 836-8957 (facsimile)

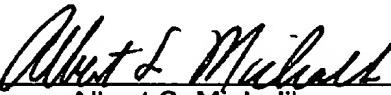
In re Application of MARTINSEN et al.
Serial No. 09/677,445

RECEIVED
CENTRAL FAX CENTER
JUL 05 2006

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this Amendment, along with transmittal and facsimile cover sheet, are being transmitted by facsimile to the United States Patent and Trademark Office in accordance with 37 C.F.R. 1.6(d) on the date shown below:

Date: July 5, 2006



Albert S. Michalik

2710 Fifth Amendment